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OFFICE OF PETITIONS

In re Application of :
Anand, et al. :
Application No. 10/565,657 : ON APPLICATION FOR
Filed: October 5, 2006 : PATENT TERM ADJUSTMENT
Atty Docket No. 05-932-A5 :
:

This is in response to the "PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)", filed November 24, 2010. Applicants submits that the patent term adjustment to be indicated on the patent is four hundred and sixty-seven (467) days, not four hundred and eighteen (418) days as calculated by the Office as of the mailing of the initial determination of patent term adjustment.

The request for reconsideration of patent term adjustment is DISMISSED.

On August 27, 2010, a "Determination of Patent Term Adjustment under 35 U.S.C. 154(b)" was mailed indicating that the initial patent term adjustment is 418 days. The instant petition under 37 CFR 1.705(b) was filed on November 24, 2010—on the same day that issue fee was paid. Petitioner asserts that the initial patent term adjustment is 467. Specifically, petitioner states that:

In the PTA calculation shown on PAIR as of November 19, 2010, a 49-day delay was attributed to Applicants for filing a corrected response to the Office's June 16, 2009, requirement for restriction. Applicants' original response was filed on July 14, 2009, and a corrected response was filed 49 days later on September 1, 2009...under 35 USC 154(b)(2)(C)(ii), Applicants could have replied at any time until September 16, 2009, without having been deemed to "have failed to engage in reasonable efforts to conclude prosecution of examination." Therefore, even though a correction to Applicant's original response was filed on September 1, 2009, it was prior to the September 16,

2009, deadline established by § 154(b)(2)(C)(ii) based on the June 16, 2009 mailing date for restriction. Accordingly, Applicants submit that the 49-day delay attributed by the Office is inappropriate as Applicants did not fail to engage in reasonable efforts to conclude processing or examination.

Excerpt taken from "PETITION FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 CFR 1.705(b)", filed November 24, 2010, pgs. 1-2.

Applicants' argument has been considered and is not persuasive. A review of the file history reveals that a restriction/election requirement was mailed June 16, 2009, to which applicants filed a response on July 14, 2009. A Notice of Non-Compliant Amendment was mailed on August 18, 2009. Applicants filed on September 1, 2009, a response correcting the omission of the July 14, 2009, response. These circumstances are governed by 37 CFR 1.704(c)(7)¹. Applicants filed a response under 37 CFR 1.704(b) on July 14, 2009. Any further responses filed after the July 14, 2009, response and before the mailing of an Office action under 37 CFR 1.702(a)(2) would subject the application to a reduction of the patent term adjustment under 37 CFR 1.704(c)(7) or (c)(8). In this case, the response under 37 CFR 1.704(b) was deemed to have an omission. The supplemental response filed on September 1, 2009, correcting the omission subjected the application to a reduction of the patent term adjustment under 37 CFR 1.704(c)(7). While applicants' assert that applicants' did not fail to engage in reasonable efforts to conclude prosecution of examination because the response and the supplemental response were filed within the three month period set forth in 37 CFR 1.704(b), 37 CFR 1.704(c)(7) makes clear that filing a response that contains an omission, or is otherwise incomplete, is a circumstance that constitutes a failure of applicants to engage in reasonable efforts to

¹ 37 CFR 1.704(c)(7) provides that:

(c) Circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application also include the following circumstances, which will result in the following reduction of the period of adjustment set forth in § 1.703 to the extent that the periods are not overlapping:

(7) Submission of a reply having an omission (§1.35(c)), in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the reply having an omission was filed and ending on the date the reply or other paper correcting the omission was filed.

conclude processing or examination of the application, notwithstanding whether the supplemental reply correcting the omission was filed within the three months of the Office Action.

In view thereof, the petition is DISMISSED.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Data Management for issuance of the patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded²).

The application file is being forwarded to the Office of Data Management for issuance of the patent.

Telephone inquiries regarding this matter should be directed to the undersigned, at (571) 272-3222.

/Kenya A. McLaughlin/

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² See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR ' 1.703(f). See also Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule, 69 Fed. Reg. 21704 (April 22, 2004).